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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,484	05/21/2001	Horst Grafe	HM-390PCT	5641
7590 Friedrich Kueffner 317 Madison Avenue New York, NY 10173		EXAMINER PRONE, JASON D		
		ART UNIT 3724		
		MAIL DATE 03/20/2009		
		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/744,484

**Applicant(s)**

GRAFE ET AL.

**Examiner**

Jason Daniel Prone

**Art Unit**

3724

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Notice of Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- 7) ☐ Paper No(s)/Mail Date: \_\_\_\_\_

### **DETAILED ACTION**

The indicated allowability of claims 6-8 is withdrawn in view of the numerous issues under 35 USC § 112 listed below.

#### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "A Device for Cutting a Work Piece in a Transport Line".

#### ***Claim Objections***

2. Claims 6-8 are objected to because of the following informalities: on line 2 of claims 6-8, the phrase "the cutting to length of strips or sheet metal" should be replaced with "the cutting of a work piece". In claims 6-8, all occurrences of the phrase "strip or sheet metal" should be replaced with "work piece". In claims 6-8, all occurrences of the phrase "rolling or transport line" should be replaced with either "rolling line" or "transport line".

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim 6:**

On lines 8-9, the phrase “the shears comprise a U-shaped frame open toward the rolling or transport line and closed at a drive side” is unclear. First it is unclear how the frame is considered open toward the rolling or transport line. The transport line extends through the middle of the frame and the frame is just as much closed towards the transport line as it is open. In order for the frame to open towards the transport line, the transport line would have to be outside of the frame adjacent items 6, 6'. Next, the term “drive side” is unclear. It is unclear if this drive side has any relation to the previously disclosed “drive apparatus”. If the drive side and drive apparatus do have direct relation, there is no disclosure that the drive apparatus is located on the side of anything, therefore it is unclear what portion makes up a drive side.

On lines 10-11, the phrase “on the U-shaped frame, at the drive side as well as a rolling table side which is opposite the drive side, holding elements are provided” is unclear. The term “rolling table side” is unclear. It is unclear if this rolling table side has any relation to the previously disclosed “rolling table”. If the rolling table side and rolling table do have direct relation, there is no disclosure that the rolling table is located on the side of anything, therefore it is unclear what portion makes up a rolling table side. It is clear the rolling table extends through the middle of the shears, so it is unclear how the rolling table could represent a side. Also, it is disclosed that the rolling table side are provided with holding elements. It can only be assumed that the rolling table side holding elements are labeled 6, 6'. Using Figure 1, the placement of 6, 6' have nothing to do with the placement of the rolling table. As stated before, the rolling table is in the

middle and can not represent a side and therefore cannot be used to designate where holding elements 6, 6' are located. In light of the issues above, it is unclear how the rolling table side and the drive side are opposites.

On lines 14-15, the phrase "an open side of an upper horizontal arm of the U-shaped frame" is unclear. It is unclear if this open side represents the same portion as the rolling table side. It is also unclear how a single arm can have an open side.

On lines 15-18, the phrase "arm of the U-shaped frame comprises at least one pressure plate and a clamping element has congruent gliding plates for overlapping the pressure plate" is unclear. The second portion of the phrase starting at "and a clamping element" is not grammatically correct. Due to these issues it is unclear whether the arm comprises the at least one pressure plate and the clamping element or just the at least one pressure plate and the clamping element stands on its own as a separate structure from the arm. Basically the use of the word "and" before "a clamping element" makes one believe the clamping element is part of the arm.

On line 18, the phrase "the pressure plate" is unclear. It is uncertain if this "pressure plate" limitation represents the same structure as the previously disclosed "at least one pressure plate".

On lines 18-22, the phrase "and that the clamping element is movable by force means on a horizontal gliding path with its gliding plates across the at least one pressure plate for generating a form-fit frictional coupling" is unclear. It is unclear what structure allows the path to be a gliding path. Basically, this limitation discloses the clamping element is movable across the plate for generating a coupling. Movement

across an item cannot generate a coupling. Some sort of structure must allow for the coupling to take place. The movement on the path would only allow for the two structures to be coupled to get closer to or further from one another. This movement cannot perform a generating couple function.

On line 20, the phrase the phrase "its gliding plates" is unclear. It is uncertain if this "its gliding plates" limitation represents the same structure as the previously disclosed "congruent gliding plates".

Applicant should note that the limitations such as "means of a drive" and "force means" are not in compliance with the Supplemental Guidelines published in the Official Gazette on July 25, 2000. Such limitations cannot be used to invoke 35 USC 112, 6<sup>th</sup> paragraph, and have therefore been given their broadest reasonable interpretation, without considering equivalence.

**Claim 7:**

On lines 8-9, the phrase "the shears comprise a U-shaped frame open toward the rolling or transport line and closed at a drive side" is unclear. First it is unclear how the frame is considered open toward the rolling or transport line. The transport line extends through the middle of the frame and the frame is just as much closed towards the transport line as it is open. In order for the frame to open towards the transport line, the transport line would have to be outside of the frame adjacent items 6, 6'. Next, the term "drive side" is unclear. It is unclear if this drive side has any relation to the previously disclosed "drive apparatus". If the drive side and drive apparatus do have

direct relation, there is no disclosure that the drive apparatus is located on the side of anything, therefore it is unclear what portion makes up a drive side.

On lines 10-11, the phrase "on the U-shaped frame, at the drive side as well as a rolling table side which is opposite the drive side, holding elements are provided" is unclear. The term "rolling table side" is unclear. It is unclear if this rolling table side has any relation to the previously disclosed "rolling table". If the rolling table side and rolling table do have direct relation, there is no disclosure that the rolling table is located on the side of anything, therefore it is unclear what portion makes up a rolling table side. It is clear the rolling table extends through the middle of the shears, so it is unclear how the rolling table could represent a side. Also, it is disclosed that the rolling table side are provided with holding elements. It can only be assumed that the rolling table side holding elements are labeled 6, 6'. Using Figure 1, the placement of 6, 6' have nothing to do with the placement of the rolling table. As stated before, the rolling table is in the middle and can not represent a side and therefore cannot be used to designate where holding elements 6, 6' are located. In light of the issues above, it is unclear how the rolling table side and the drive side are opposites.

On lines 14-15, the phrase "an open side of an upper horizontal arm of the U-shaped frame" is unclear. It is unclear if this open side represents the same portion as the rolling table side. It is also unclear how a single arm can have an open side.

On line 15-20, the phrase "arm of the U-shaped frame is provided with threaded spindle coupling rods connected so as to be pivotable..., which, by means of recesses, are engageable in congruent coupling sockets of a lower frame arm or in the congruent

coupling sockets of the holding element" is unclear. The Recesses are empty spaces and can not help perform any type of function. It is the pivotal connection that allows for the rods to pivot through recesses to engage the sockets. Therefore, the phrase "by means of recesses" is not correct.

On line 19, the phrase "a lower frame arm" is unclear. It is uncertain if this arm is similar to the upper arm and is part of the U-shape frame.

On line 20, the phrase "the congruent coupling sockets of the holding element" is unclear. It is unclear why the word before congruent is "the" and not "a". With the word "the" preceding the congruent coupling sockets of the holding element, one would believe that these sockets are the same sockets as the sockets on the lower frame arm. If this is the case, it is unclear how sockets on the lower frame arm can be the same structure as the sockets on the holding element.

On lines 21-22, the phrase "and adjustable by a force means for generating a form-fit and frictional connection with their spindle drives" is unclear. First it is unclear what structure is adjustable. Assuming it is the rods that are adjustable, it is unclear how performing and adjustment by a force means generates a form-fit connection. An adjustment function is not capable of performing a generating connection function. Two structures must form the connection. The rod may be adjusted but it is ultimately the structure of the rod that allows it to be frictionally connected with the spindle drive. Second, the term "their spindle drives" is unclear. It is uncertain what structure is represented by the term "their".



Applicant should note that the limitations such as “means of a drive” and “force means” are not in compliance with the Supplemental Guidelines published in the Official Gazette on July 25, 2000. Such limitations cannot be used to invoke 35 USC 112, 6<sup>th</sup> paragraph, and have therefore been given their broadest reasonable interpretation, without considering equivalence.

**Claim 8:**

On lines 8-9, the phrase “the shears comprise a U-shaped frame open toward the rolling or transport line and closed at a drive side” is unclear. First it is unclear how the frame is considered open toward the rolling or transport line. The transport line extends through the middle of the frame and the frame is just as much closed towards the transport line as it is open. In order for the frame to open towards the transport line, the transport line would have to be outside of the frame adjacent items 6, 6'. Next, the term “drive side” is unclear. It is unclear if this drive side has any relation to the previously disclosed “drive apparatus”. If the drive side and drive apparatus do have direct relation, there is no disclosure that the drive apparatus is located on the side of anything, therefore it is unclear what portion makes up a drive side.

On lines 10-11, the phrase “on the U-shaped frame, at the drive side as well as a rolling table side which is opposite the drive side, holding elements are provided” is unclear. The term “rolling table side” is unclear. It is unclear if this rolling table side has any relation to the previously disclosed “rolling table”. If the rolling table side and rolling table do have direct relation, there is no disclosure that the rolling table is located on the side of anything, therefore it is unclear what portion makes up a rolling table side. It is

clear the rolling table extends through the middle of the shears, so it is unclear how the rolling table could represent a side. Also, it is disclosed that the rolling table side are provided with holding elements. It can only be assumed that the rolling table side holding elements are labeled 6, 6'. Using Figure 1, the placement of 6, 6' have nothing to do with the placement of the rolling table. As stated before, the rolling table is in the middle and can not represent a side and therefore cannot be used to designate where holding elements 6, 6' are located. In light of the issues above, it is unclear how the rolling table side and the drive side are opposites.

On lines 18-20, the phrase starting with "with the aid of..." does not make sense and needs to be re-written.

Applicant should note that the limitations such as "means of a drive", "means of a joint", and "force means" are not in compliance with the Supplemental Guidelines published in the Official Gazette on July 25, 2000. Such limitations cannot be used to invoke 35 USC 112, 6<sup>th</sup> paragraph, and have therefore been given their broadest reasonable interpretation, without considering equivalence.

5. It is to be noted that claims 6-8 have not been rejected over prior art. It may or may not be readable over the prior art but cannot be determined at this time in view of the issues under 35 USC § 112.

### ***Response to Arguments***

6. The main issue of the claims appears to be, that there is no structure linking all of the limitations together. For example, the drive side is not linked to the drive apparatus and the drive apparatus is not linked to any side portion. The claims feature numerous

grammatical errors. The claims are replete with prepositional phrases that are injected in the middle of limitations making the claims very confusing. It is recommended that the claims be amended to disclose all of the structural terms and then utilizing the term "wherein" to disclose how these structures are linked.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Daniel Prone whose telephone number is (571)272-4513. The examiner can normally be reached on M-F 7-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

18 March 2009

/Jason Daniel Prone/  
Primary Examiner, Art Unit 3724